

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed January 24, 2008 (the "Office Action"). At the time of the Office Action, Claims 1, 3-20, 22-39, and 41-57 were pending in the Application and stand rejected. In order to advance prosecution of this case, Applicants have amended Claims 1, 18-20, 37-39, and 56-57. Applicants respectfully submit that no new matter has been added. Applicants respectfully request reconsideration and favorable action in this case.

Section 103 Rejections

1. Claims 1, 20 and 39

The Office Action rejects Claims 1, 3-4, 15, 20, 22-23, 34, 39, 41-42, and 53 under U.S.C. § 103(a) as being unpatentable over *Grube* in view of U.S. Patent No. 6,564,066 to Biggs, et al. ("Biggs"). Applicants respectfully traverse these rejections at least for the reasons discussed below.

As amended, Claim 1 recites receiving a request from an internet protocol phone within a packet switched environment to establish a connection to a dialed number, the internet protocol phone having a wired connection to the packet switched environment. Nowhere does the combination of *Grube* and *Biggs* disclose, teach or suggest receiving a request from an internet protocol phone within the packet switched environment to establish a connection to a dialed number, the internet protocol phone having a wired connection to the packet switched environment.

Claim 1 further recites determining a priority for the connection based on the dialed number. To the extent the combination of *Grube* and *Biggs* discloses determining priority for a connection, the combination does not disclose determining priority for a connection between an IP phone and a dialed number. More specifically, both *Grube* and *Biggs* disclose processing communications within a wireless push-to-talk environment. *See e.g., Grube, FIG. 1; FIG. 3; column 4, lines 44-45; column 7, lines 19-22; and Biggs, FIG. 1; column 3, lines 9-35.* Thus, any determination of priority disclosed by either of *Grube* or *Biggs* involves a wireless push-to-talk endpoint as either the one requesting the communication or the one to whom the request is directed.

In addition, Applicants note that replacing the push-to-talk wireless communication devices of either *Biggs* or *Grube* with IP phones having a wired connection to a packet switched network would render them unsuitable for their intended purpose. More specifically, *Grube* discloses that using a unique address for each required destination would be an undesired alternative because it would seriously impact the traffic volume carried over the disclosed network. *Grube* column 7, lines 24-28. An IP phone used in the network disclosed by *Grube* would require a unique address which would result in the very situation *Grube* advises against. *Biggs* discloses a wide area dispatch communication system utilizing radio frequency communications. *See e.g.*, *Biggs*, column 3, lines 9-14; column 7, lines 2-5; and FIG. 1. Replacing communication units 112 of *Biggs* with wired IP phones would not allow for them to be mobile units that communicate in a dispatch communication system.

Accordingly, there is no disclosure in either of *Grube* or *Biggs* of receiving a request from an internet protocol phone within a packet switched environment to establish a connection to a dialed number and determining the priority of the connection based on the dialed number. Therefore, for at least these reasons, Applicants respectfully submit that Claim 1 is allowable, as are all claims depending therefrom. For analogous reasons Applicants also submit that Claims 20 and 39 are allowable, as are all claims depending therefrom.

2. Claims 4, 23 and 42

Claim 4 is allowable at least for the reasons provided above with respect to Claim 1. In addition, Claim 4 recites that the certificate provides the communication packets with a higher priority to CPU threads processing communication packets for the connection. Nowhere does *Grube* or *Biggs* disclose the use of CPU threads for processing communication packets. The Office Action contends that this is disclosed by FIG 5, block 508 of *Grube*. *Office Action*, page 3. However, block 508 merely discloses prioritizing messages. *See Grube*, column 6, lines 39-53. Thus, while *Grube* discloses processing messages to include indicia of priority (block 504) and routing the processed message to its destination(s) (block 506), neither *Grube* nor *Biggs*, either alone or in combination disclose providing the communication packets with a higher priority to CPU threads. Accordingly,

Applicants respectfully request that this rejection of Claim 4 be withdrawn. For analogous reasons Applicants also request that these rejections of Claims 23 and 42 be withdrawn.

3. Claims 18-19, 37-38, and 56-57

The Office Action rejects Claims 5-6, 18-19, 24-25, 37-38, 43-44, and 56-57 under U.S.C. § 103(a) as being unpatentable over *Grube* and *Biggs* in view of U.S. Patent Publication No. 2001/0014095 to Kawahata, et al. ("Kawahata"). For at least the reasons provided below Applicants respectfully traverse these rejections.

Claim 18 is allowable at least for the reasons provided above with respect to Claim 1. In addition, Claim 18, as amended, recites monitoring use by an end-point of connections having an augmented priority. The Office Action contends that while *Grube* does not disclose monitoring end-point usage of augmented priority it is disclosed by *Kawahata*. *Office Action*, page 5. *Kawahata* merely discloses monitoring the congestion of IP network 16. *Kawahata*, paragraph [0125]. Simply monitoring the overall congestion of network 16 as a whole would not provide information regarding a specific endpoint's use of augmented priority. Thus, there is no disclosure monitoring use by an end-point of connections having an augmented priority. Therefore, for at least this additional reason, Applicants respectfully request that this rejection of Claim 18, and all Claims depending therefrom, be withdrawn. For analogous reasons Applicants also request that these rejections of Claims 37 and 56, and all claims depending therefrom, be withdrawn.

Claim 19 is allowable at least for the reasons provided above with respect to Claims 1 and 18. In addition, Claim 19 recites modifying the priority of the connection based on the monitored end-point use of connections having an augmented priority. The Office Action contends that while *Grube* does not disclose modifying the priority of the connection based on end-point usage it is disclosed by *Kawahata*. *Office Action*, page 5. *Kawahata* merely discloses that a user may enter "a priority control special number" which may increase the priority of the messages. *Kawahata*, paragraph [0126]. However there is not disclosure of modifying the priority of the connection based on the monitored end-point use of connections having an augmented priority. Therefore, for at least this additional reason, Applicants respectfully request that this rejection of Claim 19 be withdrawn. For analogous reasons Applicants also request that these rejections of Claims 38 and 57 be withdrawn.

4. Claims 14, 33 and 52

The Office Action rejects Claims 14, 33, and 52 under U.S.C. § 103(a) as being unpatentable over *Grube*, *Biggs* and *Uhlik* further in view of U.S. Patent Publication No. 2004/0109413 to Hierholzer, et al. (“*Hierholzer*”). For at least the reasons provided below, Applicants respectfully traverse these rejections.

Claims 14, 33, and 52 are allowable at least for the reasons provided above with respect to Claim 1. In addition, *Hierholzer* does not qualify as prior art under 35 U.S.C. § 102 and thus can not be used in a 35 U.S.C. § 103 rejection. Applicants' application was filed on December 31, 2001. The related PCT application for *Hierholzer* was filed on August 29, 2001. However the publication of the PCT application on March 21, 2002 was in German, not in English. Thus, *Hierholzer* is not entitled to its international filing date, but rather its date of publication under 35 U.S.C. § 102(e). See M.P.E.P. 706.02(f)(1). Because *Hierholzer's* U.S. patent publication date (June 10, 2004) is after Applicants' filing date *Hierholzer* does not qualify as prior art under § 102 and thus may not be used in a § 103 rejection. Accordingly, Applicants respectfully request that these rejections of Claims 14, 33, and 52 be withdrawn.

5. Claims 7-13, 16-17, 26-32, 35-36, 45-51, and 54-55

The Office Action rejects Claims 7, 26, and 45 under U.S.C. § 103(a) as being unpatentable over *Grube* and *Biggs* further in view of U.S. Patent No. 5,729,542 to Dupont (“*Dupont*”); Claims 8, 12-13, 17, 27, 31-32, 36, 46, 50-51, and 55 under U.S.C. § 103(a) as being unpatentable over *Grube* and *Biggs* in view of U.S. Patent No. 6,745,043 to Lester, et al. (“*Lester*”); Claims 9-10, 16, 28-29, 35, 47-48, and 54 under U.S.C. § 103(a) as being unpatentable over *Grube* and *Biggs* in view of U.S. Patent No. 6,600,914 to Uhlik, et al. (“*Uhlik*”); and Claims 11, 30, and 49 under U.S.C. § 103(a) as being unpatentable over *Grube*, *Biggs* and *Uhlik* further in view of *Lester*. Applicants respectfully traverse these rejections.

Claims 7-13 and 16-17 depend from Claim 1; Claims 26-32 and 35-36 depend from Claim 20; and Claims 45-51 and 54-55 depend from Claim 39. Therefore, for at least the reasons provided above with respect to Claims 1, 20, and 39, Applicants respectfully request the these rejections of Claims 7-13, 16-17, 26-32, 35-36, 45-51, and 54-55 be withdrawn.

6. The Office Action Has Not Provided Sufficient Motivation to Combine the References

In addition, notwithstanding the fact that the combination of the cited references fails to teach each element of the rejected claims, there is no motivation to combine references as suggested in the Office Action. To establish a *prima facie* case of obviousness, the references must teach or suggest all elements of the rejected claims and it must have been obvious to one of ordinary skill in the art at the time of invention to combine or modify the references. *See e.g.*, *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007); *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). In *KSR Int'l Co. v. Teleflex Inc.*, the Supreme Court clarified the appropriate standard to use when determining obviousness. 127 S. Ct. 1739-1743. "The [obviousness] analysis is objective: 'Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined.'" *Id.* at 1734 (citing *Graham v. John Deere*, 383 U.S. 1, 17-18, 148 U.S.P.Q. 459 (1966)).

A "principal reason for declining to allow patents for what is obvious" is to prevent individuals from obtaining a patent "for a combination which only unites old elements with no change in their respective functions." *Id* at 1739. However, the Supreme Court clarified that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *Id.* at 1741. "[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 1740. While not a rigid test, a showing of a "teaching, suggestion, or motivation" to combine or modify prior art provides helpful insight in determining whether it would have been obvious to combine references. *Id.* at 1739. "A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning." *Id.* (citing *Graham*, 383 U.S. at 36).

In the present case, the Office Action has not provided the analysis required to determine that it would be obvious to combine the various references used in the rejections in the manner suggested. The Office Action merely provides conclusory statements that the suggested combinations would be obvious. First, the Office Action has not clearly

articulated the scope and content of the prior art, the differences between the prior art and the claims at issue, or the level of ordinary skill in the art. Second, the Office Action provides no indication that the claims "only unite old elements with no change in their respective functions." Third, the Office Action has not shown a teaching, suggestion, or motivation to combine the references in the manner suggested. For example, with respect to the combination of *Grube* and *Biggs* the Office Action simply states that it would have been obvious "to indicate a priority according to the dialed numbers in Grube's system, as suggested by Biggs, for resource allocations and assignments." *Office Action*, page 3. The Office Action repeatedly uses this type of short conclusory sentence even when combining several references. For example, in combining four references, *Grube*, *Biggs*, *Ublik* and *Lester*, the Office Action simply states that it would have been obvious "to notify lower priority users of their terminated network resources in Grube's system, as suggested by Lester, to provide network resources for higher priority users in case of urgency." *Office Action*, pages 8-9.

The Supreme Court is clear that these types of conclusory statements are insufficient to establish obviousness: "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR*, 127 S. Ct. at 1791 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). The Office Action's conclusiveness glosses over the fact that combining *Biggs* with *Grube* would counteract one of the primary advantage sought to be achieved by *Grube*. More specifically, as discussed above, one of the goals *Grube* is to reduce the amount traffic that a network has to handle by reducing the number of different destination addresses. See e.g., *Grube* column 7, lines 24-28. In order for *Grube* to indicate priority according to a dialed numbered, as the Office Action suggests *Biggs* discloses, each of the communication units would need to have its own address. In light of the disclosure in *Grube* that it is undesirable to use unique destination addresses for each endpoint, the motivation provided by the Office Action fails to provide a motivation that is in agreement with what is actually disclosed by the references.

Thus, in addition to the failure to disclose each element of Claims 1, 3-20, 22-39, and 41-57 in the proposed combinations, there is no motivation to combine the references.

Therefore, Applicant respectfully submits that Claims 1, 3-20, 22-39, and 41-57 are patentable over the cited art used in the rejections and request that the rejections of these claims be overturned.

No Waiver

All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the references cited by the Office Action. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. By not responding to additional statements made by the Office Action, Applicants do not acquiesce to the Office Action's additional statements. The example distinctions discussed by Applicants are sufficient to overcome the Office Action's rejections.

Conclusion

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Timothy R. Gerlach, Attorney for Applicants, at the Examiner's convenience at (214) 953-6931.

The Commissioner is hereby authorized to charge any fee and credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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